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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIMON A. J. HOLDSWORTH

Appeal 2008-2482
Application 10/016,935¹
Technology Center 2100

Decided:² June 16, 2009

Before ROBERT E. NAPPI, SCOTT R. BOALICK, and
KEVIN F. TURNER, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

¹ Application filed December 14, 2001. The real party in interest is IBM Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing under 37 C.F.R. § 41.52 of our Decision on Appeal entered March 17, 2009 ("Decision") wherein we affirmed the Examiner's rejection of claims 1-14 and 16.

The request for rehearing is denied.

DISCUSSION

Appellant argues that the Decision was based on a new claim interpretation not previously presented during prosecution, thereby constituting a new ground of rejection. (Req. for Reh'g 4-6.) Specifically, Appellant argues that the Decision's interpretation of a "communication characteristic of an inter-broker communication link" represents a new ground of rejection. (Req. for Reh'g 4.) Appellant also argues: (1) that our Decision erred in finding that Owens and Narasimhan teach or suggest an *inter-broker* communication link that is *between* a message brokering system and a connected message brokering system (Req. for Reh'g 7-9, 13); and (2) that our Decision misinterpreted the claimed communication *characteristic* of an inter-broker communication link (Req. for Reh'g 9-13). In particular, Appellant argues that the Examiner and the Decision did not address where the applied prior art teaches or suggests "that the link is an inter-broker communication link and that the link is between the message brokering system and a connected message brokering system." (Req. for Reh'g 7-8.) Appellant also contends that the communication "characteristic identified by the Honorable Board and relied upon by the Examiner, however, is not a characteristic of the inter-broker communication link, as claimed. Instead,

the characteristic is one of the network, as a whole, or of the server, individually." (Req. for Reh'g 10.)

Appellant's arguments are not persuasive. Appeal to the Board is from the decision of the Examiner, not from the reasons upon which such decisions are based. *See* 35 U.S.C. §§ 6(b), 134(a). The criterion of whether a rejection is considered "new" in a decision by the Board is whether Appellant has had a fair opportunity to react to the thrust of the rejection. *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). Here, we found that Appellant had not shown error in any of the Examiner's claim rejections and agreed with the Examiner's basis for rejecting (a) claims 1-4, 10-14, and 16 under 35 U.S.C. § 103(a) as being obvious over Owens and Narasimhan, (b) claims 5 and 6 under 35 U.S.C. § 103(a) as being obvious over Owens, Narasimhan, Hurst, and Khan, (c) claim 7 under 35 U.S.C. § 103(a) as being obvious over Owens, Narasimhan, and Delaney, and (d) claims 8 and 9 under 35 U.S.C. § 103(a) as being obvious over Owens, Narasimhan, Delaney, and Khan. (*See* Decision at 11-17.) In so doing, we agreed with the Examiner's analysis that Narasimhan taught or suggested certain claim limitations, including a communication characteristic of an inter-broker communication link, and found that this comported with the broadest reasonable construction of the claim. (Decision 11-12.) The basic thrust of the rejection by the Examiner and the Board was the same, and we believe that Appellant has had a fair opportunity to react to the thrust of the rejection.

In particular, the Decision quoted the Examiner's analysis (Ans. 4, 13-14) of how Narasimhan teaches or suggests the claimed communication characteristic of an inter-broker communication link, agreed with this

analysis, and found that it comports with the broadest reasonable construction of the claim. (Decision 11-12.) In addition, the Examiner, responding to Appellant's argument that Owens does not teach or suggest the claimed "communication characteristic" (App. Br. 5), stated that "Appellant has not clearly defined what is meant by a 'communication characteristic', and as such intends broad interpretation of this limitation. Appellant should be aware that although the claims are interpreted in light of the specification, limitations from the specifications are not read into the claims." (Ans. 13.) Therefore, it appears that the Examiner and the Board were construing the claimed "communication characteristic" in a similar manner, consistent with the Specification.

Accordingly, we will not designate our affirmance as constituting a new ground of rejection under 37 C.F.R. § 41.50(b).

We do not find Appellant's other arguments regarding an inter-broker communication link that is between a message brokering system and a connected message brokering system to be persuasive. Contrary to Appellant's contention, the Examiner addressed where the applied prior art teaches or suggests this limitation at pages 3 through 5 of the Office Action mailed December 14, 2005 (the "Office Action").

In particular, the Examiner found that "Owens extensively motivated the exploration of the art of forwarding of messages between messaging brokers such as from 'information service 14 . . . to another service provider 16' (column 7 lines 27-29, column 7 line [sic] 49-62, column 8 lines 6-10 column 8 lines 39-42 and column 12 lines 19-20 and lines 41-53)." (Office Action at 4 (emphasis deleted).) The Examiner found "that in figure 6, Owens system filter [sic] and forwarding [sic] an alert to any email address.

Additionally Owens taught redirecting emails to any email address in figure 8." (Office Action at 5.) The Examiner also found that "it is clear that Owens systems (that matches the interpretation of a message broker) forwarded messages to other email systems with functionality also commensurate with the interpretation of a message broker and therefore explicitly described inter-broker communication based on the selected filtering policy represented by the filtering process" (Office Action at 5) and "[a]dditionally, Narasimhan taught determining a message filter [213], filtering [215] routing [219] messages from a source server to a designation server in figure 2 and column 3-4" (Office Action at 5). We agree with the Examiner's findings. Further, the Examiner's findings are consistent with Appellant's Specification, which teaches that "[w]ithin a message delivery system, messages may be delivered through a network of servers including one or more 'brokers' which provide routing and formatting services. The brokers are located a communications hubs within the network." (Spec. 1:20-24.)

Therefore, Appellants have not shown error in our Decision affirming the Examiner's finding that the applied prior art teaches or suggests an inter-broker communication link that is between a message brokering system and a connected message brokering system.

In addition, Appellant has not demonstrated that interpreting a "communication characteristic of an inter-broker communication link" to encompass the characteristic of whether the inter-broker communication link is effective to communicate with a server is unreasonable or inconsistent with the Specification. According to Appellant, a characteristic is "a distinguishing trait, quality, or property" and "to distinguish" is "to perceive

a difference in," "to mark as separate or different," or "to separate into kinds, classes, or categories." (Req. for Reh'g 9.) But even under Appellant's definition, whether the inter-broker communication link is effective to communicate with a server is a characteristic because effectiveness to communicate is a trait, quality, or property of the link that separates the link into kinds, classes, or categories -- namely links that are effective to communicate with the server and those that are not. Although Appellant argues that this is a characteristic of the network or of the server, Appellant has not convincingly shown why being effective to communicate with a server may not also be a characteristic of an inter-broker communication link.

Because no error has been shown, we decline to modify our Decision.

CONCLUSION

The request for rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

Appeal 2008-2482
Application 10/016,935

Ack

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